



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

[Handwritten signature]

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,816	05/04/2001	Shahaf Abileah	SVL920010039US1	1984

24852 7590 07/02/2004

INTERNATIONAL BUSINESS MACHINES CORP
IP LAW
555 BAILEY AVENUE , J46/G4
SAN JOSE, CA 95141

EXAMINER

CAO, DIEM K

ART UNIT PAPER NUMBER

2126

[Handwritten mark]

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,816

Applicant(s)

ABILEAH ET AL.

Examiner

Diem K Cao

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/12/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-12 are presented for examination.
2. The cross references related to the application cited in the specification must be updated (i.e. the relevant status, with PTO serial numbers or patent numbers where appropriate, on pages 1-2).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 09/849,105. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the instant application and the copending application is the instant application claims "a form or language running on the application server" and "the metamodel data of the target transaction manager including control data, state data, and user data", wherein the copending application claims "the transaction

Art Unit: 2126

message formatter running on the application server” and “the metamodel data of the target transaction message formatter including a message descriptor, logical page, password, segment, message field, device descriptor, device type, device division, device page and device field”. It would have been obvious to one of ordinary skill in the art all the steps of the invention are the same in both applications, and the instant application also support transaction between client and server applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 14-16, 26-28, 39 and 41 of copending Application No. 09/849,190. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only different between the instant application and the copending application is the instant application claims “a form or language running on the application server” and the copending application claims “the high level assembler running on the application server”. It would have been obvious to one of ordinary skill in the art, the language application and the high level assembler application are both legacy applications, and all the steps are identical in two applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-12 are provisionally rejected under the judicially created doctrine of

Art Unit: 2126

obviousness-type double patenting as being unpatentable over claims 1-4, 6-8, 11-13, 19 and 22 of copending Application No. 09/849,377. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the instant application and the copending application is the instant application claims “a form or language running on the application server” and the copending application claims “a language running on the application server”. It would have been obvious to one of ordinary skill in the art language is a programming language, and all the steps in the two applications are identical, therefore, one could apply any language to the system of instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 14-16, 26-28, 39 and 42 of copending Application No. 09/849,563. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the instant application and the copending application is the instant application claims “a form or language running on the application server” and the copending application claims “PL/I running on the application server”. It would have been obvious to one of ordinary skill in the art language is a programming language, and all the steps in the two applications are identical, therefore, one could apply PL/I language to the system of instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 14-16, 26-28, 39 and 42 of copending Application No. 09/849,813. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the instant application and the copending application is the instant application claims “a form or language running on the application server” and “the metamodel data of the target transaction manager including control data, state data, and user data, wherein the copending application claims “COBOL running on the application server”. It would have been obvious to one of ordinary skill in the art all the steps of the invention are the same in both applications, and COBOL is one type of programming language, which could be replaced in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 1, 5, and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10 of copending Application No. 10/310,343. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the instant application and the copending application is the instant application claims “a form or language running on the application server” and “the metamodel data of the target transaction manager including control data, state data, and user data, wherein the copending application claims “a first target language running on the application server” and “said Type Descriptor class connector metamodels

Art Unit: 2126

comprising of an Instance Type Descriptor Base class, a Type Descriptor Language Element class, and a Language Element Model inheriting from Type Description Language element class". It would have been obvious to one of ordinary skill in the art language could be any programming language, and it could be replaced by another language because all the steps are identical in both applications and both share the same purpose.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 11-12 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Claim 11 claims a product only without any function and use and the purpose of the product.

Claim Objections

12. Claims 5-7 and 10 are objected to because of the following informalities:

Claim 5 cites "to a language and a transaction manager running on the server" is unclear. Examiner interprets as "to a language for a transaction manager running on the server" for examining purpose.

Claims 7 and 10 cite "an connector" should be "a connector".

Art Unit: 2126

Appropriate corrections are required.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation " the application server " in step (d). There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation " the application server " in step (c). There is insufficient antecedent basis for this limitation in the claim.

Claim 8 cites "the connector ... to receive the application request from the server" in step (c) should be "the connector ... to receive the response to the application request from the server", and "to convert a response" in step (c) should be "to convert the response".

Appropriate corrections are required.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 2126

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devine et al (U.S. 2003/0191970 A1) in view of Yee et al (U.S. 6,738,975 B1) further in view of Mellen-Garnett et al (U.S. 6,094,688).

17. **As to claim 1**, Devine teaches

- initiating the application request on the end user application in a first language with a first application program (The customer workstation ... and front-end services; page 4, section 0058 and client-tier software ... Java classes; page 4, left column, lines 1-5 and client message, the request; page 5, section 0068 and request from an application running on the customer's workstation; page 6, section 0074),
- transmitting the application request to the server (the messages created ... Web Servers 24; page 7, section 0095 and The DMZ ... the user section; page 5, section 0068) and converting the application request from the first language of the first end user application to the legacy language application running on the application server (a translation process for translating a message into an underlying message; page 8, section 0099),
- processing the application request on the application server (other legacy or host platform ... at the client browser; page 5, section 0073),
- transmitting a response to the application request from the application server to the end user application, and converting the response from the legacy language to the first language of the first end user application (Data returned ... to client format ... response to the request; page 8, section 0099 and Any data returned from the application server is

translated back to client format and returned over the Internet to the client workstation; page 6, section 0074), and

- wherein the end user application and the application server have at least one connector therebetween (legacy adapter; page 3, section 0054 and Fig. 1 and proxy; page 8, section 0099), and the steps of (i) converting the application request from the first language of the first end user application as a source language to the legacy language running on the application server as a target language (a translation process for translating a message into an underlying message; page 8, section 0099), and (ii) converting a response to the application request from the legacy language running on the application server as a source language to the first language of the first end user application as a target language (Any data returned from the application server is translated back to client format; page 6, section 0074) using the metamodels of respective source and target language (metadata; page 6, section 0081 and proxy specific data ... providing a service; page 8, section 0097), and converting the source language to the target language (a translation process for translating a message into an underlying message; page 8, section 0099 and Any data returned from the application server is translated back to client format; page 6, section 0074).

18. However, Devine does not teach a form for the transaction manager running on the application server, and populating the connector metamodels with metamodel data of each of the respective source and target transaction manager, the metamodel data of the target transaction manager including control data, state data and user data. Devine teaches the system support

Art Unit: 2126

different type of transaction such as synchronous and asynchronous transaction type (page 6, sections 0075-0076), and control data (type of transaction; page 6, sections 0075-0076). Yee teaches populating the connector metamodels with metamodel data of each of the respective source and target languages (The user identifies ... actual output message; col. 21, lines 1-11 and A transformer implements ... to the target objects; col. 21, lines 43-55). Mellen-Garnett teaches the metamodel data of the target transaction manager including state data (state of the system, saga; col. 7, line 46 - col. 8, line 27) and user data (user name, password; col. 13, line 62 - col. 14, line 5).

19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Devine, Yee and Mellen-Garnett because Yee provides a fast and simple integration of applications, legacy applications while reduce or substantially eliminate the need for the expensive custom coding that is traditionally required to integrate applications, and the transaction service of Mellen-Garnett provides consistency across applications in the system.

20. **As to claim 2**, Devine teaches the end user application is a web browser (The customer workstation ... browser based user interface; page 3, section 0056).

21. **As to claim 3**, Devine teaches the end user application is connected to the application server through a web server, and the web server comprises a connector (customer workstation, web server, application server, adapter programs; page 3, sections 0053-0055 and Fig. 1).

22. **As to claim 4**, Devine does not teach the metamodel metadata comprises invocation metamodel metadata, application domain interface metamodel metadata, and type descriptor metamodel metadata. However, Devine teaches metadata is used (page 6, section 0081). Yee teaches connector (agent adapter) mediate differences interface protocols and data structures between applications to provide a uniform, normalized view of business event (col. 16, lines 62-65), message definition object identifies data of an enterprise application, and well-defined message format to describe the layout of the native data (col. 17, lines 49-54 and 48-61 and col. 19, lines 25-44), and mapping definition objects define how the system will transform system messages extract from one or more applications to messages needed by other applications (col. 17, lines 55-58 and col. 20, lines 53-59). Although Yee does not use the same terms as defined in the instant application, the metadata in the system of Yee covers the same as in the system of the application. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Devine and Yee because it will improve the system of Devine because the system of Yee provides an efficient and cost effective information sharing.

23. **As to claims 5 and 8**, they correspond to the method claim of claim 1 except they are transaction processing system claims.

24. **As to claims 6-7**, see rejections of claims 2-3 above.

25. **As to claims 9-10**, see rejection of claims 2-3 above.

26. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yee et al (U.S. 6,738,975 B1) in view of Mellen-Garnett et al (U.S. 6,094,688).

27. **As to claim 11**, Yee teaches connector (agent adapter) mediate differences interface protocols and data structures between applications to provide a uniform, normalized view of business event (col. 16, lines 62-65), message definition object identifies data of an enterprise application, and well-defined message format to describe the layout of the native data (col. 17, lines 49-54 and 48-61 and col. 19, lines 25-44), and mapping definition objects define how the system will transform system messages extract from one or more applications to messages needed by other applications (col. 17, lines 55-58 and col. 20, lines 53-59). Although Yee does not use the same terms as defined in the instant application, the metadata in the system of Yee covers the same as in the system of the application. Yee further teaches a metamodel metadata repository of source and target language metamodel metadata (The repository service 135 ... metadata; col. 15, lines 55-58).

28. However, Yee does not explicitly teach invocation metamodel metadata, and transaction manager metamodel data including control data, state data and user data. Mellen-Garnett teaches invocation metamodel metadata (API manipulator; col. 19, lines 6-10), and the metamodel data of the target transaction manager including state data (state of the system, saga; col. 7, line 46 - col. 8, line 27) and user data (user name, password; col. 13, line 62 - col. 14, line 5).

29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Yee and Mellen-Garnett because it improves the method for sharing information between applications written in different languages in the computing system, and the transaction service of Mellen-Garnett provides consistency across applications in the system.

30. **As to claim 12**, Yee teaches connector (agent adapter) mediate differences interface protocols and data structures between applications to provide a uniform, normalized view of business event (col. 16, lines 62-65), message definition object identifies data of an enterprise application, and well-defined message format to describe the layout of the native data (col. 17, lines 49-54 and 48-61 and col. 19, lines 25-44), and mapping definition objects define how the system will transform system messages extract from one or more applications to messages needed by other applications (col. 17, lines 55-58 and col. 20, lines 53-59). Although Yee does not use the same terms as defined in the instant application, the metadata in the system of Yee covers the same as in the system of the application.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diem K Cao whose telephone number is (703) 305-5220. The examiner can normally be reached on Monday - Thursday, 9:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

Art Unit: 2126

supervisor, Meng-Ai An can be reached on (703) 305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Diem Cao


MENG-AI T. AN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100